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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/472,654	12/27/99	FOGARTY	P TOSK-004

BRET E. FIELD  
BOZICEVIC, FIELD & FRANCIS LLP  
200 MIDDLEFIELD ROAD  
SUITE 200  
MENLO PARK CA 94025

HM22/0509

EXAMINER

PHAM, M

ART UNIT	PAPER NUMBER
1641	

DATE MAILED: 05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/472,654

Applicant(s)

FOGARTY, PATRICK

Examiner

Minh-Quan K. Pham, Ph.D.

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1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 1,6,9,10,15 and 16 is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2&3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

The amendment filed March 14, 2001, has been entered as Paper No. 6.

### *Election/Restrictions*

Applicant's election of Group I, claims 1-16, in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 5.

### *Claim Objections*

Claims 1, 6, 9-10 and 15-16 are objected to because of the following informalities:

Claims 15-16 are duplicate of claims 9-10. Applicant is requested to delete either claims 9-10 or claims 15-16.

In claim 1, line 9, the colon (":") should be deleted.

In claim 6, line 10, the colon (":") should be deleted.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "rapid generation time" in claim 3 is a relative term which renders the claim indefinite. The phrase "rapid generation time" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The term "small" in claim 4 is a relative term which renders the claim indefinite. The term "small" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Wasserkort et al. (1997), *Journal of Applied Toxicology*, 17(2):119-125.

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Wasserkort et al. disclose the screening of toxic compounds using *Drosophila melanogaster* (see Abstract and Introduction). The method comprise exposing chemicals to about 10-20 flies and determining the effect of the chemicals on CO<sub>2</sub> production is determined (see pages 119-120, Experimental). Therefore, Wasserkort et al. anticipate the invention as claimed.

Claims 1-7, 10-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Lynch et al. (1991), *Teratogenesis, Carcinogenesis, and Mutagenesis*, 11:147-173 (a reference of record).

Lynch et al. disclose a method of screening developmental toxicant using *Drosophila*. The method comprising exposing the flies (at least 200) to chemicals and determining the effects of the chemicals on mortality and morphology of the flies (see pages 149-151, Materials and Methods). Therefore, Lynch et al. anticipate the invention as claimed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 8-9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Wasserkort et al. (1997), *Journal of Applied Toxicology*, 17(2):119-125, or Lynch et al. (1991), *Teratogenesis, Carcinogenesis, and Mutagenesis*, 11:147-173 (a reference of record).

See above for the disclosure of either Wasserkort et al. or Lynch et al.

Either Wasserkort et al. or Lynch et al. differ from the claimed invention because they do not disclose that 100 or 1000 compound compositions are tested simultaneously.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to test 100 or 1000 compound compositions simultaneously in order to accomplish a large scale screening process with a minimal time requirement.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

David et al. (WO 99/37672, a reference of record), Wells (1998), *Chemistry and Biology*, 5(6):R147-R148 (a reference of record), Hirsh et al. (US 5,711,932), and Miwa et al. (US 4,444,891) are cited to show *in-vivo* testing of compounds using insects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Quan K. Pham whose telephone number is (703) 305-1444. The examiner can normally be reached on Monday to Friday, 8 AM - 5:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on (703) 305-3399. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Minh-Quan K. Pham, Ph.D.  
May 2, 2001



LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

05/05/01